

REMARKS

Favorable reconsideration is respectfully requested in view of the foregoing amendments and following remarks.

The non-elected claims are cancelled without prejudice.

Claims 1-6 are amended to recite "isolated".

The rejection of the claims under 35 USC 101 is thus deemed to be overcome.

The title of the invention has been rewritten to be more descriptive. The new title is supported by the Abstract.

Claim 24 has been amended to delete reference to the non-elected claims.

The objection to the specification and claims is thus deemed to be overcome.

Claim 15 is amended to be more descriptive. Support is found in the specification at page 58, lines 6-12.

New claim 31 is supported at page 50, lines 22-23 of the specification.

The Examiner refused to consider the Sugino reference AM cited in Applicant's IDS filed May 11, 2001, on the basis that no concise explanation of the relevance of the reference is provided. However please note that the cited reference was cited in the International Search Report in English submitted with the IDS. The search report shows the degree of relevance found by the foreign office. Under PTO rules, the search report accordingly satisfies the requirement for a concise explanation of the relevance of the reference. Please see page 600-122 of the MPEP, right column, a copy of which is enclosed. Consideration is accordingly appropriate and requested.

Claims 1-6, 15-16 and 24 are rejected under 35 USC 112, second paragraph, on the basis that the language “substantially identical” is indefinite.

The claims have been amended to remove the language “substantially identical”, such that the claims are now directed to the protein having the amino acid sequence of SEQ ID NO: 5 and 6.

Accordingly, this ground of rejection is deemed to be overcome.

Lastly, claims 1-6, 15-16 and 24 are rejected under 35 USC 102 as anticipated by Hirao et al. This ground of rejection is respectfully traversed as applied to the amended claims.

The claims have been amended to remove the language “substantially identical”, such that the claims are now directed to the protein having the amino acid sequence of SEQ ID NO: 5 and 6.

The cited reference fails to disclose an amino acid sequence according to the amended claims.


Moreover, claim 1 is directed to the ARIP1 protein. See page 121, lines 10-14 of the specification. The ARIP1 protein is a molecule that lacks the GK domain located at the N-terminus of S-SCAM. Thus the claimed protein is quite different from S-SCAM. Moreover, the claimed protein has no ability to bind to SAPAP, because the claimed protein lacks the GK domain.

Accordingly, the cited reference fails to disclose or suggest the proteins of the claims as amended.

Favorable action on the merits is solicited.

Respectfully submitted,

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Second, 37 CFR 1.98(c) states that when the disclosures of two or more patents or publications listed in an information disclosure statement are substantively cumulative, a copy of one of the patents or publications may be submitted without copies of the other patents or publications provided that a statement is made that these other patents or publications are cumulative. The examiner will then consider only the patent or publication of which a copy is submitted and will so indicate on the list, form PTO-1449, or PTO/SB/08A and 08B, submitted, e.g., by crossing out the listing of the cumulative information. But see *Semiconductor Energy Laboratory Co. v. Samsung Electronics Co.*, 204 F.3d 1368, 1374, 54 USPQ2d 1001, 1005 (Fed. Cir. 2000) (Reference was not cumulative since it contained a more complete combination of the claimed elements than any other reference before the examiner. "A withheld reference may be highly material when it discloses a more complete combination of relevant features, even if those features are before the patent examiner in other references." (citations omitted).).

37 CFR 1.98(a)(3)(ii) states that if a written English language translation of a non-English language document, or portion thereof, is within the possession, custody or control of, or is readily available to any individual designated in 37 CFR 1.56(c), a copy of the translation shall accompany the statement. Translations are not required to be filed unless they have been reduced to writing and are actually translations of what is contained in the non-English language information. If no translation is submitted, the examiner will consider the information in view of the concise explanation and insofar as it is understood on its face, e.g., drawings, chemical formulas, English language abstracts, in the same manner that non-English language information in Office search files is considered by examiners in conducting searches.

A (3) Concise Explanation of Relevance for Non-English Language Information

Each information disclosure statement must further include a concise explanation of the relevance, as it is presently understood by the individual designated in

37 CFR 1.56(c) most knowledgeable about the content of the information listed that is not in the English language. The concise explanation may be either separate from the specification or incorporated therein with the page(s) and lines of the specification where it is incorporated being noted in the IDS.

The requirement for a concise explanation of relevance is limited to information that is not in the English language. The explanation required is limited to the relevance as understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information at the time the information is submitted to the Office. If a complete translation of the information into English is submitted with the non-English language information, no concise explanation is required. An English-language equivalent application may be submitted to fulfill this requirement if it is, in fact, a translation of a foreign language application being listed in an information disclosure statement. There is no requirement for the translation to be verified. Submission of an English language abstract of a reference may fulfill the requirement for a concise explanation. Where the information listed is not in the English language, but was cited in a search report or other action by a foreign patent office in a counterpart foreign application, the requirement for a concise explanation of relevance can be satisfied by submitting an English-language version of the search report or action which indicates the degree of relevance found by the foreign office. This may be an explanation of which portion of the reference is particularly relevant, to which claims it applies, or merely an "X", "Y", or "A" indication on a search report. The requirement for a concise explanation of non-English language information would not be satisfied by a statement that a reference was cited in the prosecution of a United States application which is not relied on under 35 U.S.C. 120.

If information cited or submitted in a prior application relied on under 35 U.S.C. 120 was not in English, a concise explanation of the relevance of the information to the new application is not required unless the relevance of the information differs from its relevance as explained in the prior application.